

THIS DISPOSITION IS NOT  
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OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re North American Tobacco Import Company

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Serial No. 78/024,803

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Arnold J. Heckler, Esq. for North American Tobacco Import Company.

Ronald L. Fairbanks, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

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Before Wendel, Bucher and Drost, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

North American Tobacco Import Company has filed an application to register the mark VIKING for "cigarettes."<sup>1</sup>

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<sup>1</sup> Serial No. 78/024,803, filed September 7, 2000, based on an allegation of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) on the ground of likelihood of confusion with the mark VIKING and design, as shown below, for "glass ash trays, humidors, and cigarette boxes, trays and jars" in Class 34.<sup>2</sup>



The refusal has been appealed and applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

Before taking up the issue of likelihood of confusion, we consider first applicant's main contention in this proceeding, namely that the registered mark has been abandoned, thus "opening the door" for the granting of applicant's application. Applicant bases its argument of abandonment on the fact that the registrant, Viking Glass Company, was dissolved by court decree on May 15, 1990. Applicant has submitted a copy of a document from the State of West Virginia to this effect. Applicant states in

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<sup>2</sup> Registration No. 817,234, issued October 25, 1966, first renewal in 1986 for 20 years. An assignment of the registration from Connecticut Cape Corp. (formerly Viking Glass Company) to Dazell Co. was recorded by the Assignment Branch on January 18, 1991 at reel 0761, frame 0207.

addition that an Office search on September 6, 2001 has revealed that no assignment has been recorded of this trademark to another party through the date of this appeal.

As pointed out by the Examining Attorney in his response to the request for reconsideration, during ex parte prosecution an applicant will not be heard on matters which constitute a collateral attack on the cited registration. The certificate of registration is prima facie evidence of the validity of the registration and the registrant's exclusive right to use the mark in connection with the goods specified in the registration. 15 U.S.C. § 1057(b). Applicant's argument that, since registrant has been dissolved since 1990, it must be assumed that use of the mark has been abandoned without intent to resume use is no more than a collateral attack on the validity of the registration. While it is true that the prima facie presumption of validity of the registration may be challenged, the present ex parte proceeding is not the proper forum for such a challenge. Instead a formal cancellation proceeding should have been filed, an option which applicant chose not to pursue. Since it is not open to applicant to prove abandonment in this ex parte proceeding, applicant's arguments that mark is no longer in

use must be disregarded.<sup>3</sup> See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 165 USPQ 515 (CCPA 1970).

Giving full weight to the cited registration, we turn to the issue of likelihood of confusion, making our determination on the basis of those of the *du Pont*<sup>4</sup> factors that are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used, or are intended to be used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Considering first the respective marks, we note that although the marks must be considered in their entireties, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Normally, it is the word

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<sup>3</sup> We note that according to the Board's review of Office records, there was an assignment of the registration recorded by the Assignment Branch in 1991. (See footnote 2).

<sup>4</sup> *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

portion of a mark, rather than the design features, unless particularly distinctive, that is the more likely to be remembered and relied upon by purchasers in referring to the goods and thus it is the word portion that will be accorded more weight in determining the similarity of the involved marks. See *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ 1191 (TTAB 1994).

Here the word VIKING is the dominant portion of registrant's mark. The ship design cannot be accorded equal weight, inasmuch as purchasers would necessarily rely upon the word portion in calling for the goods. In addition, the main function of the ship design is to reinforce the word portion, by its portrayal of a Viking ship, and thus to strengthen the general impression created by the word VIKING. See *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, *supra* (coat of arms design reinforces meaning of word mark). The literal portions of the two marks are identical, the word VIKING, rendering the marks identical in sound and meaning. Moreover, as pointed out by the Examining Attorney, the term VIKING as used in connection with either applicant's cigarettes or registrant's smokers' articles, including ash trays, humidors and cigarette boxes, is totally arbitrary, having no suggestive connotation when used with goods of this

nature. All in all, the overall commercial impressions created by the marks are virtually identical. Applicant has made no argument to the contrary.

Thus, we turn to a comparison of the respective goods with which applicant and registrant are using, or intend to use, these highly similar marks. In making our analysis, we are guided by the general principle that the greater the degree of similarity in the marks, the lesser the degree of similarity that is required between the goods on which the marks are being used to support a likelihood of confusion. If the marks are virtually the same, as is the case here, there need only be a viable relationship between the goods in order to support a holding of likelihood of confusion. See *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); *In re Concordia International Forwarding Corp.*, 222 USPQ 255 (TTAB 1983).

Furthermore, it is not necessary that the goods of applicant and registrant be similar or even competitive to support a holding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the

mistaken belief that they emanate from, or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein. If there are no restrictions in the application or registration as to the channels of trade or class of purchasers, the parties' goods must be assumed to travel in all the normal channels of trade for the goods of this nature and to all the normal classes of purchasers. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

Thus, the question before us is whether a sufficient relationship exists between the cigarettes of applicant and the various smokers' articles of registrant, such as ash trays, humidors and cigarette boxes, that purchasers would be likely to believe that the goods originate from a single source, if highly similar marks are used thereon. We find the copies of several third-party registrations made of record by the Examining Attorney showing registration of the same mark by a single entity for both tobacco products including cigarettes and smokers' articles including items such as ash trays, cigarette cases, humidors, and cigarette boxes, more than adequate to establish that such a relationship exists. While these registrations are admittedly not evidence of use of the marks in commerce for

these goods, they are sufficient to suggest that the goods are of a type which may be produced by a single entity and be identified by the same mark. See *In re Albert Trostel & Sons Co.*, *supra*, *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988), *aff'd* as not citable precedent 88-1444 (Fed. Cir. November 14, 1988). Accordingly, if highly similar marks are used on both types of goods, as is the case here, it may be presumed that purchasers will mistakenly believe that the goods emanate from the same source. Furthermore, it appears only reasonable that purchasers encountering ash trays and other smokers' articles bearing the same mark as a brand of cigarettes would assume that the smokers' articles originate from the same source as the cigarettes, if no more than as promotional items. See *Larus & Brother Co. v. Holiday Designs, Inc.*, 159 USPQ 686 (TTAB 1968)(close relationship found to exist between applicant's ash trays and opposer's smoking tobacco and cigarettes).

In addition, in the absence of any limitations in the application or registration it must be presumed that the goods of both applicant and registrant would travel in the same channels of trade, be sold in the same retail outlets, and be sold to the same class of purchasers, namely, the



general public. No distinction whatsoever can be made on this basis.

Applicant's argument that neither entity specifically includes the goods of the other in its identification of goods is to no avail. The goods of the applicant and registrant need not be identical or even competitive to support a holding of likelihood of confusion. As fully discussed above, it is necessary only that a viable relationship exist between the goods such that use of similar marks on the goods results in the mistaken belief on the part of purchasers that the goods originate from a common source. This relationship has been shown to exist.

Applicant's further argument for an "equitable result" by allowing the mark VIKING to coexist for the products of both applicant and registrant would clearly be unfair to registrant. Registrant is fully entitled to the protection afforded to it by its valid and existing registration of the mark against the registration by applicant of substantially the same mark for goods closely related to registrant's goods.

Accordingly, on the basis of the virtually identical commercial impressions of the marks being used, or intended to be used, and the relationship which has been shown to

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exist between the goods of applicant and registrant, we find that confusion is likely.

Decision: The refusal to register under Section 2(d) is affirmed.

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